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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,248

11/25/2003

Yves P. Arramon

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07/17/2006

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EXAMINER

CUMBERLEDGE, JERRY L

ART UNIT

PAPER NUMBER

3733

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/723,248	<b>Applicant(s)</b> ARRAMON, YVES P.	
	<b>Examiner</b> Jerry Cumberledge	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                                                 |                                                                                        |
|-----------------------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/06/05, 06/01/04, 05/26/04</u> | 6) <input type="checkbox"/> Other: ____                                                |

## **DETAILED ACTION**

### ***Oath/Declaration***

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or supplemental oath or declaration.

It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

It does not state that the person making the oath or declaration has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration. The applicant states that the application was reviewed and understood. The correct phrase is that the specification was reviewed and understood.

### ***Claim Objections***

Claims 1, 17 and 20 are objected to because of the following informalities:

In claim 1, line 6, "drive" should be changed to --driver--.

In claim 17, line 6, there appears to be a space in the word "at". The space must be removed.

In claim 20, line 1, "aid" should be changed to the word --said--.

In claim 20, line 2, the units after "36" are missing.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19, which is a method claim, is dependent on claim 1, which is an apparatus claim. It appears that applicant intends to make claim 19 dependent on a previous method claim and the only method claim that precedes claim 19 is claim 18. Therefore, in this office action claim 19 will be considered to be dependent on claim 18.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 5, 7, 17 and 18, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Bischof et al. (US Pat. 4,915,688).

Bischof et al. disclose an implant material injection system comprising: a pressure driver (Fig. 1 below) and a separate container (Fig. 1). The pressure driver

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(Fig. 1) comprises a piston (Fig. 1) and a sleeve (Fig. 1). The system comprises a means for remote actuation (Fig. 1). The remote actuator is connected to the pressure driver (Fig. 1). The actuator is capable of movement that would correspond 1 to 1 with movement of the piston (Fig. 1).

The device of Bischof et al. is capable of performing a method of delivering flowable implant material, the method comprising: providing an implant material injection system comprising a pressure driver and container for implant material; connecting the pressure driver to cannula emplaced at a location for implant material delivery; loading the implant material into the pressure driver; driving material from the pressure driver into the implant material location; again loading implant material into the pressure driver and again driving material from the pressure driver into the implant material location.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 6, 8-16 and 19-23, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bischof et al. (US Pat. 4,915,688) in view of Kline et al. (US Pat. 5,376,094).

Bischof et al. discloses the claimed invention except for the remote actuator comprising first and second grip portions; and a cable set within a housing connecting the actuator and the pressure driver.

Kline discloses the remote actuator comprising first and second grip portions (Fig. 3 below) in order to give the handle good fidelity and allow the operator to feel resistance that the end is feeling (column 1, lines 28-31); and a cable (or remote connection) (Fig. 3) set within a housing (Fig. 3) connecting the actuator and the pressure driver (Fig. 19 below), in order to move the piston and create a suction in the pressure driver and allow for withdrawal of fluid (column 6, lines 32-34).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have constructed the implant material injection system of Bischof et al. with the actuator having first and second grip portions, in order to give the handle good fidelity (column 1, lines 28-31); and a cable set within a housing connecting the actuator and the pressure driver, in order to move the piston and create a suction in the pressure driver and allow for withdrawal of fluid (column 6, lines 32-34).

The implant material injection system of Bischof as modified by Kline is capable of performing a method of delivering flowable implant material, the method comprising: providing an implant material injection system comprising a pressure driver and container for implant material; connecting the pressure driver to cannula emplaced at a location for implant material delivery; loading the implant material into the pressure driver; driving material from the pressure driver into the implant material location; again loading implant material into the pressure driver and again driving material from the

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pressure driver into the implant material location. The implant material injection system of Bischof as modified by Kline is capable of performing a method including steps of withdrawing a first portion of the actuator relative to a second portion of the actuator to effect the loading and advancing the first portion toward the second portion to effect the driving. The device can perform the method at about 36 inches or greater from the location for implant material. The device includes a cable within a housing, which connects the remote actuator to the pressure driver. The device can perform a method in which the pressure level for driving the implant material reaches at least about 10 psi. The device can perform a method where the pressure level for driving the implant material does not exceed about 120 psi.

It has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233. The following claims have optimum or workable ranges:

With regard to claims 2 and 15 it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the implant material injection system of Bischof et al. as modified by Kline at a psi of 10 or greater.

With regard to claims 3 and 16 and, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the implant material injection system of Bischof et al. as modified by Kline at a psi of 120 or less.

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With regard to claim 9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the cable of Bischof et al. as modified by Kline about 36 inches in length or more.

With regard to claim 14, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the remote connection of Bischof et al. as modified by Kline about 36 inches in length or more.

It has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). The following claim contains an optimum value of a result effective variable:

With regard to claim 9, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the cable of Bischof et al. as modified by Kline about 48 inches long.

With regard to statements of intended use and other functional statements (e.g. "...are adapted to draw implant material..." and "...adapted to drive said piston..." and movement corresponds to 1 to 1 with movement..."), they do not impose any structural limitations on the claims distinguishable over the device of Bischof et al. in view of Kline, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA



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1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached PTO-892

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Cumberledge whose telephone number is (571) 272-2289. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

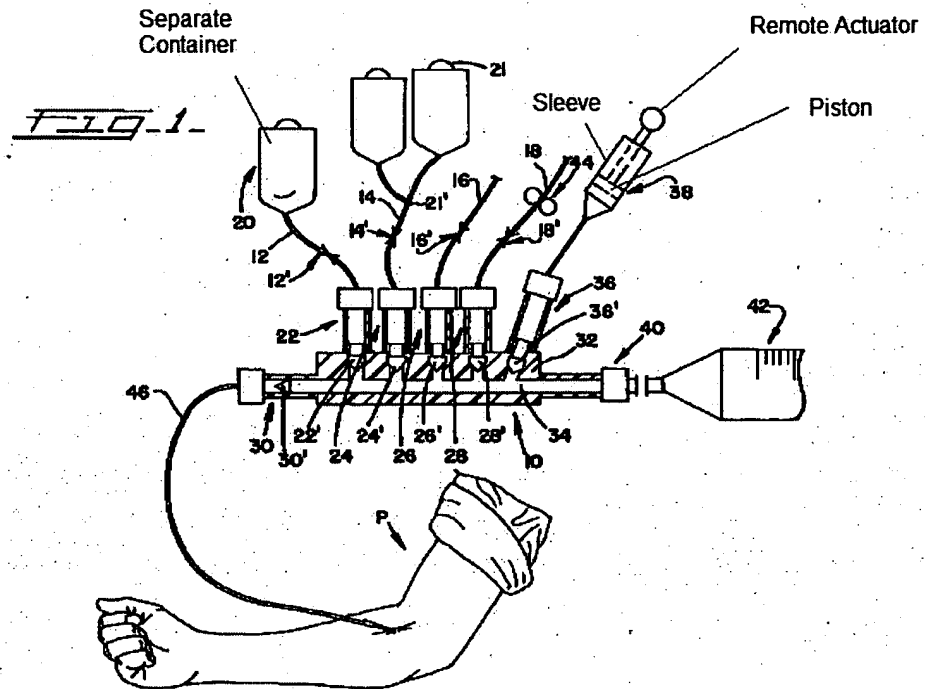
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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